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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/967,077	09/28/2001	Travis J. Parry	10005952-1	4921

7590 11/20/2003

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EXAMINER	
AMINZAY, SHAIMA Q	
ART UNIT	**PAPER NUMBER**
2674	2

DATE MAILED: 11/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/967,077	PARRY, TRAVIS J.	
	Examiner	Art Unit	
	Shaima Q. Aminzay	2674	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 September 2001* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-25* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

Detailed Action

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

    a. A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-6, 8, 14-20, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lapstun et al. (U.S. Patent No. 6627870) in view of Black (U.S. Publication No. 2001005541 A1).

3. Regarding claim 1-5 Lapstun teaches that the embodiment of (Figure 7, item 102) the pen-like sensing device or writing instrument comprising: an embodiment of 101 (Figure 7; column 14, lines 1,and 15) with the stylus (electronic pen with the ball point cartridge) and a nib 121 (Figure 7; column 14, line 16; column 2, line 26-28) for applying writing strokes (column 14, lines 38-40) on a surface. And a finger pad or grip pad 141 (Figure 7) to provide or assist holding or gripping the pen (column 13, line 64) while writing.

    Lapstun does not contain the representation of the fingerprint scanner configuration while the user's finger resting on the finger pad, and the finger print features that are convertible into code that can be mapped to the fingerprint feature to uniquely identify the user.

    Black teaches "the stylus-shaped device includes a scanner-type device component for capturing within the processor memory a written signature generated by the

stylus while the stylus is writing upon a surface. A fingerprint sensor is disposed within the grip of the stylus" (page 1, [0009] lines 3-7; page 3, [0045] lines 4-7, Figures 1A and 1B). "The term "fingerprint" refers to either the print of the thumb, index finger, or any other finger" (page 3, right column lines 1-2). The captured information is compared against the reference to identify user (page 1, [0009] lines 10-12).

Lapstun and Black are combinable because they share the same field of endeavor, namely sensing identification device technology. At the time of the applicant invention, it would have been obvious to one of ordinary skill in the art to modify the sensing device with a nib (stylus or electronic pen) of Lapstun to include a fingerprinting scanning feature as with Black. The motivation to combine would have been to provide a sensing device (or stylus) with fingerprinting-scanning feature and to ensure that the user is authorized to use the device (see paragraph 0009, lines 10-15). It would have been obvious to combine Lapstun and Black to obtain the invention of claims 1-5.

4. Regarding claim 6 and 18 Lapstun does not teach the data transmission of the writing instrument to a remote location via wireless receiver to a remote location. Black teaches, "The wireless transponder submits data to the interrogator. Thereafter, when the customer uses a stylus to submit written data (such as a signature), a sensor in the stylus makes incidental capture of biometric data that enables the interrogator to confirm customer identity. Similarly, the system can be used to confirm identity" ([0025], page 2 second column lines 2-6). Further, Black "discloses a system for authenticating remote users in a distributed environment"

(page 1, [0004] lines 1-3 and more information in lines 3-11).

At the time of the applicant invention, it would have been obvious to one of ordinary skill in the art to modify the sensing device with a nib (stylus) of Lapstun to include the wireless technology as with Black to provide a sensing device (stylus) with fingerprinting-scanning and wireless feature.

5. Regarding claim 8 Lapstun does not teaches the writing instrument code is used to create an electronic signature

Black teaches that "the stylus-shaped device includes a scanner-type device component for capturing within the processor memory a written signature generated by the stylus while the stylus is writing upon a surface (page 1, [0009] lines 3-6; page 3, [0045] lines 4-7, Figures 1A and 1B). "A fingerprint sensor is disposed within the grip of the stylus. The fingerprint sensor enables the capture of a digital signature of the writer at the same time that the written signature of the writer is captured. Once the identity of the writer has been authenticated by comparison against a reference print, the signature of the writer irrefutable. The device serves the same general purpose and can be used in lieu of a signature pad" (page 3, [0045] lines 8-12).

At the time of the applicant invention, it would have been obvious to one of ordinary skill in the art to modify the sensing device with a nib (stylus) of Lapstun to include a fingerprinting scanning device including method and instruction of identifying fingerprint-signature as with Black. The motivation to combine would have been to provide a sensing device (stylus) with fingerprinting-scanning, private/public key for public use.

6. Regarding claims 14, and 15 Lapstun and Black specifically do not teaches the affixing of the electronic signature to an electronic document, scanning of electronic document and affixing it to the electronic document and its method.

However, Black teaches, "The method for document authentication exploits a temporally variable physical process to generate a reproducible effect that cannot be copied (page 4, [0056] lines 4-5). The time-varying image of the document is electronically captured, digitized, and stored in an electronic media. The photo sensor signal is compared to the stored data; a match indicates a valid document, and no match indicates an invalid or unauthorized document. The image recognition process can be enhanced by comparing the rate of change in a sequence of images elicited by the laser illuminator (page 4, [0056] lines 28-32, and page 5 (first column) lines 1-2). Many identification systems are known in the art. In some cases, a photograph of a subject or his fingerprint pattern is affixed to an identification card. In other approaches, various methods are employed for storing images" ([0002]). Black further, teaches the scanning fingerprint and electronic signature in section [0009]. Black's teaching clearly indicates the method of affixing of the electronic signature to an electronic document, scanning of electronic document.

At the time of the applicant invention, it would have been obvious to one of ordinary skill in the art to modify the sensing device with a nib (stylus) of Lapstun to include a fingerprinting scanning device including a method of affixing electronic signature to electronic document for public use. The motivation to combine would have been to provide a sensing device (stylus) with fingerprinting-scanning feature.

7. Regarding claims 16, 19, 20, and 23 Lapstun does not teach the computer-readable media containing executable instruction to receive fingerprint data to create electronic signature, identifying the unique features of the fingerprint, and incorporating it into electronic signature.

   Black teaches that the stylus captures the user's fingerprint data and the captured data is stored in processor memory while an electronic signature is created. The captured fingerprint data is identified and the signature is irrefutable (Page 1, [0009] lines 3-7, page 3 [0045] lines 4-7, 8-12). Black further, teaches the use of unique fingerprint-electronic signature data in private and public key code with examples in sections [0064-0074]. However, it is well known in the art the computer processor executes computer program instructions, the process of scanning, capturing the fingerprint, creating electronic signature, creating and identifying public and private key cod, take place through the computer executable instructions.

   At the time of the applicant invention, it would have been obvious to one of ordinary skill in the art to modify the sensing device (stylus) of Lapstun and add the fingerprinting-scanning and signature as with Black. The motivation to combine would have been to provide a sensing device with fingerprinting and scanning signature feature.

   It would have been obvious to combine Lapstun sensing device and Black fingerprinting-scanning technology with the well-known art of computer-readable media to obtain the invention of claims 16, 19, 20, and 23.

8. Claims 9, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lapstun et al. (U.S. Patent No. 6627870) in view of Keronen (U.S. Patent No.

6304907 A1).

Lapstun does not teaches the fingerprint scanning, private and public key code, and electronic signature to uniquely identify the fingerprint and readable media to provide instructions (computer executable) and its method.

Keronen teaches that *"the Internet pen 10 and corresponding display access terminal 11" (column 4, lines 35-36) includes "a scanning device 32" (column 4, line 63), "the authentication unit 28 may include a fingerprint verify arrangement which can recognize the fingerprint of the user (or owner) of the Internet pen 10 and only allow operation of the Internet pen 10 if the fingerprint (eg. a thumbprint) of a desired user is recognized" (column 6, lines 11-16), "the user can be identified by the fingerprint verify arrangement and the Internet pen 10 can transmit via an information packet a corresponding verify code that allows the user to perform the transaction or release information as desired" (column 6, lines 26-30), "the device 70 can be any one of a number of known arrangements for providing authentication input ("the input device 70 (either a PINpad or a fingerprint scanner)" (column 10, lines 14-15)), these including keypads into which a personal identification number (PIN) can be inserted or a fingerprint scanning device such as known in the art" (column 9, lines 33-37), "The Internet pen 10A also include a private encryption key memory 78 and an encryption device 76 which allow for encrypting information to be transmitted from the Internet pen 10A to allow for secure communication with service accessible via the display access terminal 11" (column 9, lines 49-53), "If authentication is valid (yes), control passes to step 108 where the challenge received at step 104 is communicated via the packet encoder/decoder 41 to the*

encryption device 76 which then encrypts the challenge packet using the private key stored within the memory 78. When the challenge packet is appropriately encrypted, at step 110, the encrypted packet is then returned to the service which performs decryption of the encrypted challenge packet using a public key to authenticate the Internet pen 10A for the performance of the requested transaction. (column 11, lines 10-20).

At the time of the applicant invention, it would have been obvious to one of ordinary skill in the art to modify the sensing device with a nib (stylus) of Lapstun to include the "*method and apparatus for convenient access of digital networks" (column 1, lines 6-7)* as with Keronen. The motivation to combine would have been to "*provided a remote control apparatus for accessing a desired resource on a network system, the network system having a plurality of node sites of which at least one said node site includes the resource, the resource being uniquely identifiable by a resource identifier*" (Keronen column 3, lines 34-38)

9. Claims 7, 10, 12, 13, 17, 21, 22, 24, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lapstun et al. (U.S. Patent No. 6627870) in view of Black (U.S. Publication No. 2001005541 A1), and further view of Keronen (U.S. Patent No. 6304907 A1).

10. Regarding claim 7, 21 and 22 as to the limitation directed to private key and public key, see remarks disclosed in claim 9.

11. Regarding claim 13 as to the limitation directed to electronic signature, see remarks disclosed in claim 8.

12. Regarding claims 10, 12, 17, 24 and 25 as to the limitation directed to electronic signature, see remarks disclosed in claim 8; as to the limitation directed to private key and public key, see remarks disclosed in claim 9.

Conclusion

1. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
2. Black discloses a method for identity verification.
3. Black discloses a data security system
4. Bergstrom discloses a fingerprint sensor and position controller
5. Corboline et al discloses a real time fingerprint verification systems that includes a recording and a verification apparatus each having a fingerprint scanner.
6. Chen et al discloses a touch controlled device and its method with pressure sensing electronic input pen.
7. Meadows, II et al discloses an automatic fingerprint identification system including the method of coding and decoding and transmitting information to external media.
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shaima Q. Aminzay whose telephone number is 703-305-8723. The examiner can normally be reached on 8:00-5:00.
9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard A Hjerpe can be reached on 703-305-4709. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.
10. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

S. A.

JOSEPH MANCUSO
PRIMARY EXAMINER